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EXAMINER
VIDA, MELANIE M

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2697	4

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/449,972	Applicant(s) HAYASAKI, MINORU	
	Examiner Melanie M Vida	Art Unit 2697	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 November 1999* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 November 1999* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement(s) (IDS) submitted on 3/9/00 has been considered by the examiner and is attached to this office action.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. **Claim 1** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,777,617. Although the conflicting claims are not identical, they are not patentably distinct from each other because the image processing apparatus in the application has similar means to the data output apparatus in the patent, (col. 7, lines 50-55). For instance, the application claims a receiving means for receiving image information, which reads on the means that "receives code data from an external

apparatus, and generates image data from the received code data", (col. 7, lines 51-54). Further, the storage means for storing image information received by said receiving means in the application, reads on a means for an "input buffer means for storing the received code data", (col. 7, lines 55-56). The discriminating means for discriminating among modes used when the image information is output by said output means", reads on a "determination means for determining in which one of a plurality of output modes including the first and second modes said data output apparatus is set", (col. 7, lines 62-65). Finally, the "control means, in which after the image information is output by said output means in accordance with discrimination by said discriminating means, said control means performs control so that the image information output by said output means is not stored in said storage means", reads on the "control means for, when said determination means determines that said data output apparatus is set in the first mode, controlling said intermediate buffer means and said output buffer means such that the image generated at a first size designated by the external apparatus from the intermediate data stored in said intermediate buffer means is stored in said output buffer means and the generated image data is sent from said output buffer means to an output section of said data output apparatus and thereafter the stored intermediate data is deleted from said intermediate buffer means", (col. 7, line 66 through col. 8, line 9).

5. **Claim 8** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 5,777,617. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method for controlling an image processing apparatus in the application is similar to the method of controlling data a data output apparatus in the patent. For instance, the steps of receiving

image information, and storing the image information in storage in the application, reads on an "input buffer for storing code data received from an external apparatus, an intermediate buffer for storing intermediate data generated from the code data stored in the input buffer", (col. 8, lines 44-48). Further, the step of outputting the image information received in the receiving step in the application, reads on "an output buffer for storing image data generated from the intermediate data stored in the intermediate buffer, and which outputs the image data from the output buffer", (col. 8, lines 47-51). Also, the step of discriminating among modes used when the image information is output in the output step, reads on the step of "determining which one of first or second modes is set", (col. 8, lines 50-54). Finally, the step of "controlling said image processing apparatus so that after the image information is output in accordance with the discrimination in the discriminating step, the image information output in the output step is not stored in said storage", reads on the step of "controlling the intermediate buffer and the output buffer such that the image data generated at a first size designated by the external apparatus from the intermediate data stored in the intermediate buffer is stored in the output buffer, and the generated image data is sent from the output buffer to an output section of the data output apparatus and thereafter the stored intermediate data is deleted from the intermediate buffer in the event that it is determined in said determining step that the first mode is set", (col. 8, lines 54-63).

6. **Claim 2** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,777,617. Although the conflicting claims are not identical, they are not patentably distinct from each other because in the application, the first mode "stores the image information received by said receiving means in

said storage means, which reads on the patent "the second mode". "the stored intermediate data is retained in said intermediate buffer means", (col. 8, lines 10-19). Further, in the application, the second mode, "information received by said receiving means without storing the image information received by said receiving means in said storage means", which reads on the first mode in the patent "thereafter the stored intermediate data is deleted from said intermediate buffer means", (col. 7, line 66- col. 8, line 9).

7. **Claim 9** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 5,777,617. Similar to the reasons for the double patenting rejection of claim 2, the "first mode" in the application reads on "the second mode" in the patent, and the second mode in the application reads on the first mode in the patent, (col. 8, line 43-col. 9, line 5), (See the reasons given for claim 2 above).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. **Claims 1, 2, 8, 9** are rejected under 35 U.S.C. 102(e) as being anticipated by Kishimoto, USP 5,777,617, (hereinafter, Kishimoto), as cited by applicant.

Regarding, **claim 1,** as shown in figure 1, an image recording apparatus, which reads on "an image processing apparatus", has a data developer unit (2) that analyzes inputted print data and a CPU (21) generates image data recognizable by the user, which reads on "a receiving means for receiving image information", (col. 2, lines 49-51; col. 3. lines 63-64). Further, an image memory (25) develops the generated image data, which reads on "storage means for storing the image information received by said receiving means", (col. 3, line 64-65). Image data transfer is carried out on a one scan image unit basis, and the image data is transferred by using a scan buffer (26) in response to a synch signal for the video I/F (27), which reads on "output means for outputting the image information received by said receiving means", (col. 3, lines 27-30). The CPU (21), further checks if the control is in test printing mode or normal printing mode, which reads on "discriminating means for discriminating among modes used when the image information is output by said output means", (col. 3, lines 50-51; lines 55-57). The CPU (21) processes data in accordance with the control procedure of figures 4A, and 4B, which reads on "control means", (col. 4, lines 45-47). After, the print mode, test mode A, B or normal, is determined (S6), the image information is output (S15), and then deleted from page buffer (23), which reads on "in which after the image information is output by said output means in accordance with discrimination means, said control means performs control so that the image

information output by said output means is not stored in said storage means", (figures 4A-4B; col. 4, lines 16-20; lines 24-27).

Regarding, **claim 2, 8, 9,** please refer to the like teachings of claim 1.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. **Claim 6, 13** is rejected under 35 U.S.C. 102(e) as being anticipated by Hayashi et al. USP 6,426,809, (hereinafter, Hayashi).

Regarding, **claim 6,** as illustrated in figure 1, an image transmitting system, Hayashi teaches that a transmission section (7), transmits the transmission data selected by the selection section (6) to a public line, network line, etc, which reads on "an image communication apparatus connectable to an image output apparatus", (col. 6, lines 44-46). A mode determination section (14) analyzes a first image data, and a second image data and the selection data output by the attribute separation section (11), determines whether or not each data plane contains

significant information, which reads on "determining means for determining whether or not an image to be transmitted to said image output apparatus is a specific image", (col. 5, lines 7-11). As shown in figure 1, a transmission section (7), is coupled to the selected data outputted by the attribute separation section (11), that determines whether or not each data plane contains significant information, and determines the transmission format mode, which reads on "transmitting means for transmitting the information of the image", (col. 5, lines 10-13). As shown in figure 8, a mode determination section of the image transmitting system, a text color data plane is coupled to mode 0, and a background image data plane is coupled to mode 1, which reads on "in a first format or a second format in accordance with the determination by said determination means", (col. 10, lines 60-67).

Regarding, **claim 13,** please refer to the like teachings of claim 6.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. **Claims 3, 10** rejected under 35 U.S.C. 103(a) as being obvious over Kishimoto, USP 5,777,617, (hereinafter, Kishimoto), as applied to claim 1, and claim 8 above, and further in view of well-known prior–art, (MPEP 2144.03).

Regarding, **claim 3,** Kishimoto fails to expressly disclose, "the image information stored in said storage means is set so as to be overwritten", (lines 6-8).

The examiner takes Official Notice of the fact that it is well known in the art to overwrite data using an EPROM or erasable programmable memory, or read/write memory.

It would have been obvious to anyone of ordinary skill in the art at the time of the invention to use read/write memory because memory is widely available and inexpensive to implement.

Regarding, **claim 10,** please refer to the like teachings of claim 3.

13. **Claims 4, 5, 11, 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kishimoto, USP 5,777,617, as applied to claim 1 and 8 above, and further in view of Teramoto, JP 409130573, (hereinafter, Teramoto).

Regarding, **claim 4,** Kishimoto teaches all the image processing apparatus and methods in claim 1, and 8, but fail to expressly disclose that the "discriminating means discriminates among said modes when the image information output by said output means is to be charged or when the image information output by said output means is not to be charged".

However, Teramoto teaches that a job processing section (35) discriminates whether the command indicates execution or cancellation of a print, which reads on "discriminating means discriminates among said mode", (see abstract, solution, lines 3-5). Further, this job processing section (35), analyzes the job and a charge for execution of the job and for printing, which reads on "when the image information output by said output means is to be charged or when the image information output by said output means is not to be charged", (see abstract, solution, lines 3-5; lines 10-11).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Kishimoto's discriminating means with Teramoto's teachings of discriminating a charge or no charge for a print job.

One of ordinary skill in the art would have been motivated to discriminate a charge or no charge in order to depict the cancellation of a print, so that the output device does not print, given the express suggestion of Teramoto, (see abstract, solution, lines 14-17).

Regarding, **claim 5,** Kishimoto teaches all the image processing apparatus and methods in claim 1, and 8, but fail to expressly disclose that the "discriminating means discriminates among said modes, based on an instruction from an image-information transmitter".

However, Teramoto teaches of a job processing section (35), that discriminates whether the command indicates execution or cancellation of a print, which reads on "discriminating means discriminates among said modes", based on a command received by the communication section (34), which reads on "based on an instruction from an image-information transmitter", (see abstract, solution, lines 8-10).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Kishimoto's discriminating means with Teramoto's communcation section (34).

One of ordinary skill in the art would have been motivated to do use a communication section (34) across a local area network.

Regarding, **claim 11,** please refer to the like teachings of claim 4.

Regarding, **claim 12,** please refer to the like teachings of claim 5.

14. **Claims 7, 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al. USP 6,426,809, as applied to claim 6, 13 above, and further in view of Kadota, USP 6,078,399, (hereinafter, Kadota).

Regarding, **claim 7,** Hayashi teaches an image communication apparatus with determining means, and transmitting means as in claim 6 above, and claim 13, which reads on "determining means has determined that the image to be transmitted to said image output apparatus is the specific image".

Hayashi fails to expressly disclose the following: "said transmitting means transmits the information of the image in the form of a page description language, while when said determining means has determined that the image to be transmitted to said image output apparatus is not the specific image, said transmitting means transmits the information of the image in the form of bitmap data".

However, Kadota teaches that according the printer driver process of FIG. 3, the personal computer 4, transfers font data as described in the PDL language to the laser printer 2, which reads on said transmitting means transmits the information of the image in the form of a page description language". The personal computer 4 transfers all data other than the font data to the laser printer 2 as bitmap image data in the HBP format. Therefore, data of a type requiring a large amount of processing to create bitmap data, such as vector graphics described in the PDL language, is transmitted as HBP bitmap image data, which reads on "while when said determining means has determined that the image to be transmitted to said image output apparatus is not the specific image, said transmitting means transmits the information of the image in the form of bitmap data", (col. 14, lines 58-66).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Hayashi's transmitting means with Kadota's method of transmitting PDL and bitmap data.

One of ordinary skill in the art would have been motivated to do transmit PDL and bitmap image data because some data types require a lot of processing in order to convert to bitmap image data, given the express suggestion of Kadota, (col. 14, lines 60-66).

Regarding, **claim 14,** please refer to the like teachings of claim 7.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakayama et al. US Publication 2003/0118242 A1, encoding apparatus and method, and storage medium.

Maeda, US Publication 2003/0107776 A1, a internet facsimile apparatus and facsimile communication.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie M Vida whose telephone number is (703) 306-4220. The examiner can normally be reached on 8:30 am 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on (703) 305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-6743 for regular communications and (703) 308-6743 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Melanie M Vida
Examiner
Art Unit 2697

mmv

MMV
July 14, 2003

KA Williams

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